

REMARKS

Claims 2-15 are pending in the Application. Claims 14 and 15 have been amended and claim 1 is cancelled.

Applicant would like to bring to the attention of the Examiner that co-pending U.S. Patent Application S.N. 10/695,151, US Pub 2005-0090861 (the '151 application) was filed the same day as, has substantially the same specification and drawings as, and claims subject matter that is similar to, the present application. Therefore, Applicant is amending Figure 1 of this specification according to amendment submitted in the '151 application, and is concurrently submitting an Information Disclosure Statement, citing the '151 application and all references cited in the '151 application that are not already of record.

Drawings

Figure 1 has been amended to add reference number 30, which had been inadvertently omitted from the original Figure 1. No new matter has been added. Applicant is concurrently submitting a replacement sheet of Figure 1 herein, including this change. Applicant respectfully requests that amendment to Figure 1 be entered.

Claim rejections – 35 U.S.C. §112

Claim 15 has been amended to more specifically point out that the active element comprises the "agent carrier", which is believed to overcome the rejection under §112 of dependent claims 2-5, 8-11, 13 and 14. Claim 14 has been amended by changing "bioactive material" to "bioactive agent". No new matter has been added.

Claim rejections – 35 U.S.C. §102 (b)

Claims 2-9, 11-13 and 15 stand rejected under 35 U.S.C. § 102(b) for allegedly

being anticipated by U.S. Patent No. 5,833,705 (Ken et al). Applicant respectfully disagrees. In order to sustain a rejection under § 102(b), the respective reference must disclose each and every element of the claim, either expressly or inherently. Applicant respectfully submits that Ken cannot support the § 102(b) rejection because it does not disclose each and every element of the rejected claims.

Ken discloses a vaso-occlusive coil with a stretch resistant member disposed within its lumen. Independent claim 15, however, recites an active element carried in the lumen of the vaso-occlusive device, the active element comprising an agent carrier that **expands or contracts** when placed in a body, wherein the expansion or contraction of the active element **causes the occlusive member to substantially retain its shape when deployed in a body cavity**.

The stretch resistance member of Ken primary purpose is to prevent stretching of the vaso-occlusive coil, as indicated in Ken and restated by the Examiner. However, this purpose is accomplished when the stretch resistance member provides the stiffness necessary to hold the coil in place. Applicant respectfully disagrees with the Examiner indication under section 6 of the Office Action that the stretch resistance member inherently **compresses and elongates** with the bending of the occlusive member as it is positioned in the body. The materials used in constructing the stretch resistance member are metals or their alloys "*tailored to accomplish and appropriate blend of flexibility and stiffness*" as stated in Ken (Col 4, lines 17-28). The stretch resistant member of Ken would be able to bend with the bending of the occlusive member and would be able to maintain its stiffness after the occlusive member it is positioned in the body, but it is factually incorrect and not

consistent with the disclosure of Ken that a stretch resistance member necessarily inherently would compress/contract and elongate/expands.

The following definitions of "compress", as well as the attributed sources, are provided from www.dictionary.com:

1. to press or squeeze together
2. to reduce in size or volume as if by squeezing

Merriam-Webster's Medical Dictionary, © 2002 Merriam-Webster, Inc.

1. to press together; force into less space.
2. to cause to become a solid mass.
3. to condense, shorten, or abbreviate.

—Synonyms 1. condense, squeeze, constrict. See contract.

—Antonyms 1. expand, spread.

Dictionary.com Unabridged. Based on the Random House Unabridged Dictionary, © Random House, Inc. 2006

The following definitions of "elongate", as well as the attributed sources, are provided from www.dictionary.com:

1. make long or longer by pulling and stretching.

WordNet® 2.1, © 2005 Princeton University

1. to draw out to greater length; lengthen; extend.
2. to increase in length.
3. extended; lengthened.

Dictionary.com Unabridged. Based on the Random House Unabridged Dictionary, © Random House, Inc. 2006.

A stretch resistance member, as indicated in Ken, is a part of a vaso-occlusive coil that withstands compression or elongation forces, "preventing stretching of the coil during movement of that coil" (first page, 57 lines 10-11). No reference or suggestion is made in Ken that the stretch resistance member would compress or elongate, since this is contrary to its purpose. The function of providing stretch resistance by the stretch resistance

member in Ken is clearly different from the contraction/compression and expansion/elongation provided by the claimed active element – agent carrier.

Additionally, the agent carrier of claim 15 comprises or otherwise carries a ***bioactive agent*** that elicits a ***biological reaction*** inside a body. Neither of these claim limitations are disclosed or suggested by Ken.

For at least these reasons, independent claim 15 (as amended), as well as dependent claims 2-9 and 11-13 are believed patentable over Ken.

Claim rejections – 35 U.S.C. §103

Claim 10 stands rejected under 35 U.S.C. § 103 for allegedly being unpatentable over Ken in view of U.S. Patent No. 6,953,465 (Dieck et al). Claim 14 stands rejected under 35 U.S.C. § 103 for allegedly being unpatentable over Ken in view of U.S. Patent No. 5,658,308 (Snyder et al). Claims 10 and 14 incorporate all of the elements and limitations of, and are therefore allowable for at least the same reasons as, claim 15, as neither Dieck et al. nor Snyder et al. provides the limitations of claim 15 that are missing in Ken

CONCLUSION

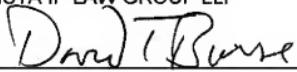
For the reasons set forth above, Applicant respectfully submits that currently pending claims are patentable over the cited prior art. A notice of allowance is respectfully requested.

If there are any questions concerning this amendment and response, please contact the undersigned at the number below.

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Respectfully submitted,
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FIG. 1

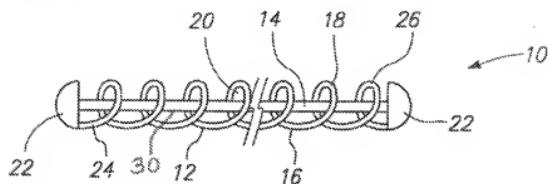


FIG. 2

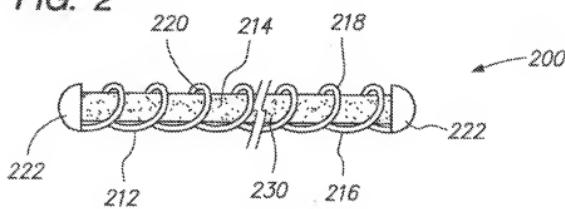


FIG. 3

